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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,279	05/05/2005	Silvia Fonquerna Pou	09605.0001	1079
22852	7590	03/12/2008		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
EXAMINER				
GALLIS, DAVID E				
ART UNIT		PAPER NUMBER		
1625				
MAIL DATE		DELIVERY MODE		
03/12/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/509,279

Applicant(s)

POU ET AL.

Examiner

DAVID E. GALLIS

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26, 28 and 31-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-26, 28 and 31-33 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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1. Claims 1 through 26, 28, and 31 through 33 are pending. Claims 1, 5, 7, 10 through 16, 18, 20, 22 through 26, 28, 31, and 32 have been amended. Claims 27, 29 and 30 have been cancelled. Claim 33 has been added.

Election/Restrictions

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicants are required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1, 2, 3, 5 through 22, and 28, drawn to a compound and composition of formula I, wherein only one of A, B, C, and D is a nitrogen atom, classified in class 546, and various subclasses.

Group II, claims 1, 2, 4 through 22, and 28, drawn to a compound and composition of formula I, wherein only two of A, B, C, and D are nitrogen atoms, classified in class 544, and various subclasses.

Group III, claims 1, 5 through 22, and 28, drawn to a compound and composition of formula I, wherein more than two of A, B, C, and D are nitrogen atoms, classified in various classes and various subclasses.

Group IV, claims 23 through 25, and 33, drawn to process for producing a compound of formula I with a reactive intermediate of general formula XI, wherein only one of A, B, C, and D is a nitrogen atom, classified in various classes and various subclasses.

Group V, claims 23 through 25, and 33, drawn to process for producing a compound of formula I with a reactive intermediate of general formula XI, wherein only two of A, B, C, and D are nitrogen atoms, classified in various classes and various subclasses.

Group VI, claims 23 through 25, and 33, drawn to process for producing a compound of formula I with a reactive intermediate of general formula XI, wherein more than two of A, B, C, and D are nitrogen atoms, classified in various classes and various subclasses.

Group VII, claim 26, drawn to a compound formula X, wherein one of A, B, C, and D is a nitrogen atom, classified in class 546 and various subclasses.

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Group VIII, claim 26, drawn to a compound formula X, wherein two of A, B, C, and D is a nitrogen atom, classified in class 544, and various subclasses.

Group IX, claim 26, drawn to a compound formula X, wherein three of A, B, C, and D is a nitrogen atom, classified in various classes and various subclasses.

Group X, claim 26, drawn to a compound formula X, wherein four of A, B, C, and D is a nitrogen atom, classified in various classes and various subclasses.

Group XI, claims 31 and 32, drawn to method for treating a subject afflicted with a pathological condition or disease susceptible to amelioration by antagonism of H1 histamine receptors, comprising administering to said subject an effective amount of a compound of formula 1, wherein only one of A, B, C, and D is a nitrogen atom, classified in class 514 and others, and various subclasses.

Group XII, claims 31 and 32, drawn to method for treating a subject afflicted with a pathological condition or disease susceptible to amelioration by antagonism of H1 histamine receptors, comprising administering to said subject an effective amount of a compound of formula 1, wherein only two of A, B, C, and D are nitrogen atoms, classified in class 514 and others, and various subclasses.

Group XII, claims 31 and 32, drawn to method for treating a subject afflicted with a pathological condition or disease susceptible to amelioration by antagonism of H1 histamine receptors, comprising administering to said subject an effective amount of a compound of formula 1, wherein more than two of A, B, C, and D are nitrogen atoms, classified in class 514 and others, and various subclasses.

1. The inventions listed as Groups I through XII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:
2. Claim 26 is drawn to a compound of formula X and reads with no dependency on subject matter claimed in claims 1 through 22, 28, and 31 through 33. By the Markush defining formula I of claim 1, no $L_1-(W_1)_n-L_2$ moiety can be characterized as hydrogen. Therefore, since formula X of claim 26 is distinct and shares no "essential structural

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element" with other claims, claim 26 and claims 1 through 22, 28 and 31 through 33 are not linked through a single inventive concept or special technical feature (i.e. formula I).

The following are MPEP guidance regarding "Markush Practice" with respect to PCT Rule 13.2:

"Markush Practice.": The situation involving the so-called "Markush practice" wherein a single claim defines alternatives (chemical or non-chemical) is also governed by Rule 13.2. In this special situation, the requirement of a technical interrelationship and the same or corresponding special technical features as defined in Rule 13.2, shall be considered to be met when the alternatives are of a similar nature.

(i) When the Markush grouping is for alternatives of chemical compounds, they shall be regarded as being of a similar nature where the following criteria are fulfilled:

(A) all alternatives have a common property or activity, and

(B)(1) a common structure is present, i.e., a significant structural element is shared by all of the alternatives, or

(B)(2) in cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

(ii) In paragraph (B)(1), above, the words "significant structural element is shared by all of the alternatives" refer to cases where the compounds share a common chemical structure which occupies a large portion of their structures, or in case the compounds have in common only a small portion of their structures, the commonly shared structure constitutes a structurally distinctive portion in view of the existing prior art. The structural element may be a single component or a combination of individual components linked together.

The only common cores of compounds of formula I and formula X are the pyrrolopyridine, pyrrolopyrimidine, pyrrolotriazine, and pyrrolotetrazine functionalities.

These are not applicants' contribution over the prior art.

3. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Gallis whose telephone number is 571-272-9068. The examiner can normally be reached on Mon-Thur 8:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-1600. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

David E. Gallis
Patent Examiner

/ Bernard Dentz/

Primary Examiner, Art Unit 1625